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IN THE

Supreme Court of the United States

October Term, 1971
No. A-78

71-419

BATES INDUSTRIES, INC.,

Petitioner,

vs.

DAYTONA SPORTS CO. and DAYTONA PRODUCTS, INC., and PAULSON MANUFACTURING CORPORATION,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

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BATES INDUSTRIES, INC.,

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vs.

DAYTONA SPORTS CO. and DAYTONA PRODUCTS, INC., and PAULSON MANUFACTURING CORPORATION,

Respondents.

Petition for a Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit.

The petitioner Bates Industries, Inc. respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appels for the Ninth Circuit entered in this proceeding on April 26, 1971.

Opinion Below.

The opinion of the Court of Appeals is reported as *Bates Industries, Inc. v. Daytona Sports Co.*, 441 F. 2d 1110 (9 Cir. 1971), and appears in Appendix A hereto. The District Court's opinion is reported at 310 F. Supp. 311 (D.C. Cal. 1969).

Jurisdiction.

The judgment of the Court of Appeals for the Ninth Circuit was entered on April 26, 1971. This petition for certiorari was filed within ninety days thereof for

jurisdictional purposes, such ninety-day period having been extended by order of Mr. Justice Douglas dated August 21, 1971. This court's jurisdiction is invoked under 28 U.S.C. section 1254(1).

Questions Presented.

1. Whether the courts below improvidently granted and erroneously affirmed summary judgment invalidating certain claims of petitioner's utility patent and a related design patent on the ground of obviousness.

2. Whether in making such determination of obviousness the courts below failed to apply and properly bring to bear upon the issue of validity of petitioner's patents the guidelines, considerations and criteria required by this Court to be employed in such cases.

Statutory Provisions Involved.

Section 103 of the Patent Act of 1952, 35 U.S.C. section 103:

> "A patent may not be obtained . . . if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. . . ."

Section 171 of the Patent Act of 1952, 35 U.S.C. section 171:

> "Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

"The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided."

Section 282 of the Patent Act of 1952, 35 U.S.C. section 282:

"A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it."

Federal Rules of Civil Procedure, 28 U.S.C., Rule 56(b):

"A party against whom a claim . . . is asserted . . . may, at any time, move with or without supporting affidavits for a summary judgment in his favor as to all or any part thereof."

Statement of the Case.

The utility and design patents in suit, issued in 1963 and 1965, afford a trim and attractive as well as effective solution to the problem of protecting motorcyclists and other wearers of headgear from the sun and wind. The inventors, Walter R. Hiatt and Michael M. King, and petitioner as their assignee, believed at the time of issuance of the patents and now assert that petitioner's protective helmet with pivotally attached flip-up face shield represents a substantial advance over the ineffective sun visor-helmet combinations of the British "Stadium" brand visor and the "McHal assembly", these being the sole prior art cited to or relied upon by the courts below. The District Judge accurately described the results of petitioner's invention as follows, 310 F. Supp. at 312-313:

"The '918 patent claims a combination consisting of three elements: (1) a standard crash

helmet with three male snap fasteners rigidly mounted on the forehead portion, said helmet being old in the art, (2) an adapter band using snap fasteners on the helmet, the adapter band continuing around to the sides of the helmet with snap fasteners located on its ends, to which the shield is pivotally attached, and (3) a transparent plastic shield which is pivotally mounted to the adapter band so that it can be rotated up and away from the wearer's face, but is ordinarily held in place by a stop means so that it substantially covers and protects the face of the wearer.

"The snap fasteners on the adapter band are not rigidly mounted; two of the three snap fasteners that mount the assembly to the helmet can slide a small distance along the length of the band. This permits the adapter band to be attached easily to helmets of various sizes and shapes, wherein the distance between the three standard snap fasteners may vary to a small extent. The stop means used to lock the shield in place consists of a male element of a snap fastener which locks into a corresponding hole on the visor or shield."

The District Court found the stop means utilized by petitioner's helmet was not "a mere transposition of elements" and accordingly that genuine issues of fact material to the validity of Claim 3 of the utility patent precluded summary judgment with respect thereto (310 F.Supp. at 316). Claims 1 and 2, however, were found to be "merely a combination of old elements which did not accomplish a new result" (310 F.Supp. at 315; 441 F.2d at 1111). Although the District Court based

its invalidation of petitioner's design patent upon lack of newness and originality under 35 U.S.C. § 171 (310 F.Supp. at 316), the Court of Appeals considered the finding (except to the extent involving the additional finding of primary functionality of the design) actually to be bottomed upon the same factual considerations as those underlying the striking down of the utility patent ("The differences relied upon are not non-obvious", 411 F.2d at 1112).

In reaching its conclusion of obviousness the District Court made several clearly erroneous factual determinations (illustrative is the finding that the McHal assembly accomplished all of the objectives the patentees listed in the utility patent application, 310 F.Supp. at 314; the uncontroverted fact was rathe· that such application included as a chief object thereof the *elimination* of the cumbersome, unpivotable peaked sun visor which principally characterized the McHal assembly, as noted at 310 F.Supp. 313). Most pertinent herein, however, are the District Court's separate, not-less-than-five-times reiterated findings that "it was not a new idea" to eliminate the peaked visor structure, as petitioner's helmet did; or to slidably mount snap fasteners on an adapter band such that the adapter band could readily be used interchangeably with different helmets; or to extend the adapter band to the sides of the helmet and to place fasteners on the ends of the band in order to pivotally mount a transparent shield; or to use a stop means to hold the flip-up shield in place over the wearer's face; or to eliminate the peaked visor in order to position the

transparent shield close to the wearer's face (310 F. Supp. at 315). A cursory reading of the opinions below demonstrates that the ultimate conclusion of obviousness is predicated entirely upon findings that the separable "not new idea" elements of petitioner's patents existed in, or were anticipated by, one or the other of two prior art references. Petitioner respectfully submits that the decisions below were properly rendered only if, as a matter of law, such findings of non-newness or existence in the prior art of *individual elements* of petitioner's new combination alone suffice to compel a holding that the statutory command of nonobviousness has not been met.

REASONS FOR GRANTING THE WRIT.

Granting certiorari herein will (1) serve to settle important issues of patentability as to which the Circuits have tended to diverge; (2) enable this Court to expand upon the guidance to the lower federal courts in interpreting the nonobviousness requirement provided by *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, 15 L.ed.2d 545, 556, 86 S.Ct. 684 (1966) and *United States v. Adams*, 383 U.S. 39, 51-52, 15 L. ed.2d 572, 580, 86 S.Ct. 708 (1966); and (3) promote the uniform administration of the patent system.

Granting certiorari will afford this Court an opportunity in the exercise of its supervisory function to deliver a cautionary admonition directing adherence to the following patent law principles, none of which was observed by the lower courts herein.

1. The Statutory Presumption of Patent Validity Must Always Be Overcome.

The courts below omitted even to mention, and entirely ignored, the statutory presumption of validity arising from the issuance of a patent and conferred by 35 U.S.C. § 282. As Mr. Justice Cardozo remarked in *Radio Corporation of America v. Radio Laboratories*, 293 U.S. 1, 7, 55 S.Ct. 928, 931, 79 L.ed. 163: "A patent regularly issued * * * is presumed to be valid until the presumption has been overcome by convincing evidence of error." And in *Radio Corporation of America, et al. v. Radio Engineering Laboratories, Inc.*, 292 U.S. 1, 7-8, 54 S.Ct. 752, 755, 78 L.ed. 1453, 1458: ". . . [O]ne otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than dubious preponderance."

Every reasonable doubt should be resolved against the defendant who is attempting to show invalidity. *Mumm v. Jacob E. Decker & Sons,* 301 U.S. 168, 171, 57 S.Ct. 675, 81 L.ed. 983, 985. The presumption has been said to be ". . . not an idle gesture . . . and is not to be overthrown except by clear and cogent evidence. . . ." *Copease Mfg. Co. v. American Photocopy Equipment Co.,* 298 F.2d 772, 777 (7 Cir. 1961).

> "If the burden on the defendant to overthrow the presumption of validity 'is a heavy one,' it follows that courts should be slow to hold any patent which has been duly issued, void on its face." *Gatch Wire Goods Co. v. W. A. Laidlaw Wire Co.,* 108 F.2d 433, 435 (7 Cir. 1939).

Also so holding are *Mercantile National Bank of Chicago v. Quest, Inc.,* 303 F.Supp. 926, 932 (D.C. Inc. 1969); *Bela Seating Company v. Poloron Products, Inc.,* 297 F.Supp. 489, 507 (D.C. Ill. 1968); *United States Gypsum Co. v. Dale Industries, Inc.,* 383 F.2d 497, 502 (6 Cir. 1967); *Hughes Aircraft Co. v. General Instrument Corp.,* 275 F.Supp. 961, 972-973 (D.C. R.I. 1967); *Walt Disney Productions v. Fred A. Niles Communications Center,* 369 F.2d 230, 234 (7 Cir. 1966); *King-Seeley Thermos Co. v. Tastee Freez Industries, Inc.,* 357 F.2d 875, 879 (7 Cir. 1966); *Arthur J. Schmitt Found. v. Stockham Valves & Fittings, Inc.,* 292 F.Supp. 893, 906-907 (D.C. Ala. 1966); *Technicon Instruments Corp. v. Coleman Instruments, Inc.,* 255 F.Supp. 630, 640 (D.C. Ill. 1966); *Holley v. Outboard Marine Corporation,* 241 F.Supp. 657, 662 (D.C. Ill. 1964); *Mott Corporation v. Sunflower Industries, Inc.,* 314 F.2d 872, 877 (10 Cir. 1963); *Hazeltine Research, Inc. v. Dage Electric Company, Inc.,* 271 F.2d

218, 224 (7 Cir. 1959); *Artmoore Co. v. Dayless Mfg. Co.*, 208 F.2d 1, 3 (7 Cir. 1953); *Charles Peckat Mfg. Co. v. Jacobs*, 178 F.2d 794, 801 (7 Cir. 1949), cert. den. 339 U.S. 915, 70 S.Ct. 575, 94 L.ed. 1340.

2. The Proper Focus Is Upon the Invention as a Whole, and Not Upon the Individual Elements or Features Disclosed Singularly in the Prior Art.

Preliminarily it may be noted that the courts below are clearly in error to the extent their holdings sustain respondents' contention (310 F.Supp. at 314) that petitioner's patents were "anticipated" by the prior art. The anticipation doctrine is generally used in connection with 35 U.S.C. § 102 and is considered inappropriate to the issue of obviousness under 35 U.S.C. § 103. *Application of Lachance*, 390 F.2d 990, 993-994 (C.C.P.A. 1968); *In re Hughes*, 345 F.2d 184 (C.C.P.A. 1965). The doctrine is in any event inapposite here, as the District Court's opinion itself reveals that the peaked visor structure of the prior art McHal assembly did not contain the adapter band and all other elements of petitioner's patents united in the same way to perform an identical function:

> ". . . anticipation is strictly a technical defense. As set forth in *Walker v. General Motors Corporation*, 362 F.2d 56, 58 (9th Cir. 1966),
>
> > '"* * * Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function" in a single prior art reference "there is no anticipation." *Stauffer v. Slenderella Systems of California, Inc.*, 254 F.2d 127, 128 (9th Cir. 1957); see also *National Lead Co. v. Western Lead Prods. Co.*, 324 F.2d 539, 554 (9th

Cir. 1963); *McCullough Tool Co. v. Well Surveys, Inc.*, 343 F.2d 381, 398 (10th Cir. 1965).'

See also *Ceramic Tilers Supply v. Tile Counsel of America,* 378 F.2d 283, 284, 285 (9th Cir. 1967); and *Ling-Temco-Vought v. Kollsman Instrument Corp.*, 372 F.2d 263, 267 (2nd Cir. 1966).

" . . .

"Accordingly, in order for the summary judgment here sought by Defendant to be proper, there must be found in one of the Stedman and Cohen patents, relied on by Defendant, *'all of the elements' of Plaintiff's claimed invention 'united in the same way' to perform the 'identical function.'* . . ." [Emphasis added.] *Schlumberger Limited v. Douglas Furniture of Cal.*, 275 F.Supp. 73, 75, 76 (D.C. Cal. 1967).

And as has been noted with regard to the doctrine of anticipation: ". . . [A] finding which * * * picks out one element in one prior patent and another element in another prior patent as a demonstration of anticipation, is manifestly insufficient to overcome the presumption arising from the issuance of the patent . . ." *Ry-Lock v. Sears Roebuck & Co.*, 227 F.2d 615 (9 Cir. 1955), cert. den. 350 U.S. 987, 76 S.Ct. 474, 100 L.ed. 854. See also, *Topliff v. Topliff,* 145 U.S. 156, 161, 12 S.Ct. 825, 827-828, 36 L.ed. 658.

The obviousness test of 35 U.S.C. § 103 merely means that a patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. *Tatko Brothers Slate Co. v. Hannon,* 157 F.Supp. 277, 282 (D.C.Vt. 1957), rev'd on other grounds, 270 F.2d 571, cert. den. 361 U.S. 915, 80 S.Ct. 260, 4 L.ed.2d 185.

As this Court's *Graham* decision has pointed out, obviousness to the hypothetical person having ordinary skill in the art is an illusive *factual* matter to be determined by a trial court. To be ascertained are the scope and content of *all* of the prior art and the differences between such prior art and the claims at issue; the level of ordinary skill in the pertinent art must be factually determined; and such considerations as commercial success, long felt but unsolved needs, and the failure of others to accomplish the claims at issue should also be taken into account. *Graham v. John Deere Co.,* 383 U.S. at 17, 15 L.ed.2d at 556, 86 S. Ct. 684; *Eimco Corporation v. Peterson Filters and Engineering Co.,* 406 F.2d 431, 435 (10 Cir. 1968), cert. den. 395 U.S. 963, 89 S.Ct. 2105, 23 L.ed.2d 749; *Application of Sporck,* 301 F.2d 686, 690 (C.C.P.A. 1962); *Application of Wagner,* 371 F.2d 877 (C.C.P.A. 1967), cert. den. 389 U.S. 1057, 88 S.Ct. 811, 19 L.ed.2d 857, rehearing denied 390 U.S. 1000, 88 S.Ct 1201, 20 L.ed.2d 101; *Application of Bulina,* 362 F.2d 555, 558 (C.C.P.A. 1966).

The District Court in applying the obviousness test herein appears to have considered only that (1) each of the individual elements of petitioner's patents "was not a new idea" and (2) such combination of old elements did not "accomplish a new result" (310 F.Supp. at 315). It is well established, however, that patentability is not dependent upon either or both "new ideas"

or "new results". Since at least as early as this Court's decision in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 67, 43 S.Ct. 322, 67 L.ed. 523, the question of patentability has been held properly to focus upon "the invention as a whole". In *United States v. Adams*, 383 U.S. 39, 15 L.ed. 2d 572, 86 S. Ct. 708, concepts which were all old individually were united, ". . . each of the elements of the Adams battery [being] well known in the prior art . . .", 383 U.S. at 51-52, 15 L.ed.2d at 580, 86 S.Ct. 708. In *Diamond Rubber Co. of New York v. Consolidated Rubber Tire Co.*, 220 U.S. 428, 55 L.ed. 527, 31 S.Ct. 444, 451, this Court said: ". . . *the elements of a combination may be all old.* In making a combination the inventor has the whole field of mechanics to draw from." [Emphasis added.]

". . . That the elements are old does not preclude patentability. . . ." *Baut v. Pethick Construction Company*, 262 F.Supp. 350, 357 (D.C.Pa. 1966); ". . . The mere recital of the known elements in the art does not, without more, invalidate the patent under Section 103. . . ." *Shaw v. E. B. & A. C. Whiting Company*, 417 F.2d 1097, 1104 (2 Cir. 1969); ". . . separate presence in the prior art of each element of combination will not prevent a finding of invention. *Wham-O-Mfg. Co. v. Paradise Mfg. Co.*, 327 F.2d 748 (9th Cir. 1964)." *Blumcraft of Pittsburgh v. Citizens & South. Nat. Bank of S. C.*, 286 F.Supp. 448, 456 (D.C.S.C. 1968), rev'd on other grounds 407 F.2d 557, cert. den. 395 U.S. 961, 89 S.Ct. 2103, 23 L.ed.2d 747, rehearing denied 396 U.S. 870, 90 S.Ct. 39, 24 L.ed.2d 125; ". . . It is idle to say that combinations of old elements cannot be inventions; substantially every invention is for such a 'combination': that is to say, it con-

sists of former elements in a new assemblage. *All the constituents may be old. . . ." Reiner v. I. Leon Co.*, 285 F.2d 501, 503-504, per L. Hand, *J.* [Emphasis added].

> "At best, one could only say that the elements of Plaintiffs' combination are disclosed singularly in the prior art. This, however, is not enough and, if the patented combinations would not have been obvious, then the patents are valid. *United States v. Adams,* 383 U.S. 39, 86 S.Ct. 708, 15 L.Ed.2d 572 (1946)." *Hirs v. DeLaval Turbine, Inc.*, 286 F.Supp. 754, 759-760 (D.C.Fla. 1968).
>
> "The fact that the Podlesak method combined separate steps that were old and revealed in the prior art does not negate patentability. *Copease Mfg. Co. v. American Photocopy Equip. Co.*, 298 F.2d 772 (7th Cir., 1961). In addition, that no one discovered the patented method until Podlesak, though the individual steps were available for so long, is evidence of nonobviousness. See *United States v. Adams,* 383 U.S. 39, 51, 52, 86 S.Ct. 708, 15 L.Ed.2d 572 (1966)." *National Dairy Products Corp. v. Borden Co.*, 394 F.2d 887, 890 (7 Cir. 1968).

". . . as stated by Mr. Justice Clark in *United States v. Adams,* 383 U.S. 39, 50, 86 S.Ct. 708, 713, 15 L.ed.2d 572 (1966), whether the individual elements of a combination are old 'begs the question,' as 'If such a combination is novel, the issue is whether bringing them together as taught by Adams was obvious in the light of the prior art.' Thus, where the invention sought to be patented resides in a combination of old elements, the proper inquiry is whether *bringing them*

together was obvious and not, whether one of ordinary skill, having the invention before him, would find it obvious through hindsight to construct the invention from elements of the prior art." *Application of Warner,* 379 F.2d 1011, 1016 (C.C.P.A. 1967), cert. den. 389 U.S. 1057, 88 S.Ct. 811, 19 L.ed.2d 857, rehearing denied 390 U.S. 1000, 88 S.Ct. 1201, 20 L.ed.2d 101. See also, *Long v. Arkansas Foundry Company,* 247 F.2d 366, 370 (8 Cir. 1957); *Mercantile National Bank of Chicago v. Quest, Inc., supra,* 303 F.Supp. 926, 932 (D.C. Ind. 1969); *Copease Mfg. Co. v. American Photocopy Equipment Co., supra,* 298 F. 2d 772, 780-781 (7 Cir. 1961); *Application of Aufhauser,* 399 F.2d 275, 280-281 (C.C.P.A. 1968); *Zero Manufacturing Co. v. Mississippi Milk Producers Association,* 358 F.2d 853 (5 Cir 1966); *Blaw-Knox Company v. I. D. Lain Company,* 230 F.2d 373 (7 Cir. 1956); *Matherson-Selig Co. v. Carl Gorr Color Card, Inc.,* 301 F.Supp. 336, 341-342 (D.C. Ill. 1967).

Emphasis by the courts below upon the alleged fact that petitioner's patents did not "accomplish a new result" was also misplaced, and certainly not determinative of patentability.

> "Whether the elements are old or new, the new arrangement or combination of them is an entity entirely distinct from the elements and is patentable if it either produces a new result *or performs an old result in an improved manner. . . .*" [Emphasis added.] *Marvel Specialty Company v. Bell Hosiery Mills, Inc.,* 216 F.Supp. 824, 826 (D.C.N.C. 1963).
>
> ". . . when elements old in the art are combined together in a manner which secures a new and useful result *or an old result in a more facile,*

economical and efficient manner, there is a patentable combination. *McCullough Tool Co. v. Well Surveys, Inc., supra; Oliver United Filters, Inc. v. Silver,* 10 Cir., 206 F.2d 658, cert. denied 346 U.S. 943, 74 S.Ct. 308, 98 L.Ed. 416." [Emphasis added.] *Eimco Corporation v. Peterson Filters and Engineering Co.,* 406 F.2d 431, 434 (10 Cir. 1968), cert. den. 395 U.S. 963, 89 S.Ct. 2105, 23 L.ed.2d 749.

". . . A patentable invention, within the ambit of 35 U.S.C § 103, *may* result even if the inventor *has,* in effect, merely combined features, old in the art, for their known purpose, *without producing anything beyond the results inherent in their use.* . . ." [Emphasis added.] *Application of Sponnoble,* 405 F.2d 578, 585 (C.C.P.A. 1969).

"A novel combination of old elements which so cooperate as to produce a . . . substantial increase in efficiency is patentable. *Lewyt Corporation v. Health-Mor, Inc.,* 7 Cir., 181 F.2d 855, 857, 858; *Helms Products v. Lake Shore Mfg. Co., supra,* 227 F.2d 681; *Weller Mfg. Co. v. Wen Products, Inc.,* 7 Cir., 231 F.2d 795, 798; *Mojonnier Dawson Co. v. United States Dairies Sales Corp.,* 7 Cir., 251 F.2d 345." *Copease Mfg. Co. v. American Photocopy Equipment Co., supra,* 298 F.2d 772, 781-782 (7 Cir. 1961). See also *Mercantile National Bank of Chicago v. Quest, Inc., supra,* 303 F.Supp. 926, 932 (D.C.Ind. 1969); *Walt Disney Productions v. Fred A. Niles Communications Center, supra,* 369 F.2d 230, 234 (7 Cir. 1966).

3. Simplicity Is No Proper Criterion of Obviousness.

Petitioner believes the courts below to have been beguiled by the seeming simplicity of its patented helmet structures. It is of no significance, however, that "viewed after the event, the means * * * adapted seem simple and such as should have been obvious to those who worked in the field, but this is not enough to negative invention." *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.*, 321 U.S. 275, 279, 64 S.Ct. 593, 594, 88 L.ed. 721.

> ". . . But it is plain from the evidence, and from the very fact that it was not sooner adopted and used, that it did not, for years, occur in this light to even the most skillful persons. It may have been under their very eyes; they may almost be said to have stumbled over it; but they certainly failed to see it, to estimate its value, and to bring it into notice. * * * Now that it has succeeded, it may seem very plain to anyone that he could have done it as well. This is often the case with inventions of the greatest merit." *Carnegie Steel Company v. Cambria Iron Company,* 185 U.S. 403, 446, 22 S.Ct. 698, 715, 46 L.ed. 968.

In overturning the lower court's invalidation of an "old" device for a windshield sun visor designed to clamp onto an automobile without welding or perforation of the automobile body, the Seventh Circuit noted:

> "That Peckat's device now seems comparatively simple, of course, is no criterion of his invention. 'The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the

> same field, it had never occurred to anyone before. The practiced eye of an ordinary mechanic may be sufficiently trusted to see what ought to be apparent to everyone.' *Potts v. Creager,* 155 U.S. 597, 608, 15 S.Ct. 194, 39 L.Ed. 275. . . ." *Charles Peckat Mfg. Co. v. Jacobs, supra,* 178 F.2d 794, 801 (7 Cir. 1949), cert. den. 339 U.S. 915, 70 S.Ct. 575, 94 L.ed. 1340.

"The fact that the invention seems simple after it is made is not determinative of the question of obviousness. If this were the rule, many of the most beneficial patents would be stricken down. . . ." *Application of Van Wanderham,* 378 F.2d 981, 987 (C.C.P.A. 1967); *Application of Sporck, supra,* 307 F.2d 686, 690 (C.C.P.A. 1962). ". . . [S]implicity, far from being an objection to invention, 'may constitute its great excellence and value.' *Chesapeake & Ohio Railway Co. v. Kaltenbach,* 4 Cir. 1938, 95 F.2d 801, 804; '* * * some of the simplest advances have been the most non-obvious.' [Citations omitted.]" *Diamond International Corporation v. Walterhoefer,* 289 F.Supp. 550, 553 (D.C.Md. 1968). ". . . But the fact that the solution was simple does not mean the solution was obvious . . . Courts have rejected as a test of invention the apparent simplicity of an invention when viewed in retrospect. [Citations omitted.]" *AMP Incorporated v. Vaco Products Co.,* 280 F.2d 518, 520-521 (7 Cir. 1960), cert. den. 364 U.S. 921, 81 S.Ct. 286, 5 L.ed.2d 260. "It is also insisted that the idea involved in appellee's device is so simple and obvious it does not constitute invention. True, it now has that appearance. The fact, however, that this improvement was long overlooked, using devices far less satisfactory, cannot be ignored." *Pyle Nat. Co. v. Lewin,* 92 F.2d 628, 630 (7 Cir. 1937).

". . . [A] 'little modification' can be a most unobvious one." *Application of Irani,* 427 F.2d 806, 809 (C.C.P.A 1970). ". . . [O]ften, as here, simple changes are unobvious when viewed in light of the history of the art. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45, 43 S.Ct. 322, 67 L.Ed. 523 (1923), . . ." *Garrett Corporation v. United States,* 422 F.2d 874 884 (C.C. 1970). ". . . [I]t is elementary that small changes in a crowded art *may constitute invention.*" *In re Baum,* 123 F.2d 662, 664 (C.C.P.A. 1941); *Application of Lange,* 280 F.2d 165, 168 (C.C.P.A. 1960). ". . . The fact that, viewed after the event, the means which the patentee adopted seem simple and such as *should* have been obvious to those skilled in the trade, is not enough to negative invention. . . ." *Tatko Brothers Slate Co. v. Hannon, supra,* 157 F.Supp. 277, 283 (D.C. Vt. 1957), rev'd on other grounds, 270 F.2d 571, cert. den. 361 U.S. 915, 80 S.Ct. 260, 4 L.ed.2d 185. "The simplicity of this useful invention is, in retrospect, some evidence that it was not obvious to a person of ordinary skill in the art. . . . *Expanded Metal Co. v. Bradford,* 214 U.S. 366, 29 S.Ct. 652, 53 L.Ed. 1034." *Application of Shelby,* 311 F.2d 807, 810 (C.C.P.A. 1963).

In *Application of Sporck, supra,* it was said, 301 F.2d at 689:

> "Once appellant's solution to the problem of making a tapered wall frusto-cone is disclosed, it is easy to see how the prior references can be modified and manipulated to produce this type of cone. The change admittedly is simple and by hindsight seems obvious. However, the simplicity of new inventions is oftentimes the very thing that is not obvious before they are made. . . ." See also,

Application of Cable, 347 F.2d 872, 878 (C.C.P.A 1965); *National Sponge Cushion Co. v. Rubber Corp.*, 286 F.2d 731, 735 (9 Cir. 1961), cert. den. 368 U.S. 976, 82 S.Ct. 480, 7 L.ed.2d 438; *Neff Instrument Corporation v. Cohu Electronics, Inc.*, 298 F.2d 82, 88 (9 Cir. 1961); *Calhoun v. State Chemical Manufacturing Company*, 153 F. Supp. 293, 296 (D.C. Ohio 1957).

4. Hindsight Reconstruction May Not Be Employed in Assessing Obviousness.

Closely related is the prohibition against the use of hindsight in 35 U.S.C. § 103 evaluations, for as this Court has observed:

> ". . . Knowledge after the event is always easy, and problems once solved present no difficulties, indeed, may be represented as never having had any, and expert witnesses may be brought forward to show that the new thing which seemed to have eluded the search of the world was always ready at hand and easy to be seen by a merely skillful attention. But the law has other tests of the invention than subtle conjectures of what might have been and yet was not. . . ." *Diamond Rubber Co. of N. Y. v. Consolidated Rubber Tire Co., supra*, 220 U.S. 428, 435, 31 S.Ct. 444, 447, 51 L.ed. 527.

Petitioner believes the courts below "slipp[ed] into hindsight" in the manner cautioned against by *Graham v. John Deere Co., supra*, 383 U.S. at 36, 15 L. ed.2d at 566, 86 S.Ct. 684 and *Monroe Auto Equipment Co. v. Heckethorn Mfg. & Supply Co.*, 332 F.2d 406, 412 (6 Cir. 1964), cert. den. 379 U.S. 888, 85 S.Ct. 160, 136 L.ed.2d 93.

Such use of hindsight reconstruction of the prior art to arrive at a conclusion of obviousness has often been held to be impermissible.

> ". . . But only through hindsight does the design appear obvious, which of course is not the test. In applying the test of invention over prior art, we must bear in mind that hindsight is more revealing than foresight. *Preformed Line Products Co. v. Fanner Mfg. Co.*, 328 F.2d 265, 271 (6th Cir. 1964), cert. den'd. 379 U.S. 846, 85 S.Ct. 56, 13 L.Ed.2d 51. . . ." *Blumcraft of Pittsburgh v. Citizens & South. Nat. Bank of S.C., supra,* 286 F.Supp. 448, 455 (D.C.S.C. 1968), rev'd on other grounds 407 F.2d 557, cert. den. 395 U.S. 961, 89 S.Ct. 2103, 23 L.ed.2d 747, rehearing denied 396 U.S. 870, 90 S.Ct. 39, 24 L.ed.2d 125.
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> "'* * * "Hindsight" is not a proper basis for determining patentability. While a particular solution to a problem may seem simple in retrospect, after its disclosure, foresight applied as of the date of the invention is the only proper test of invention. * * *'" *Matherson-Selig Co. v. Carl Gorr Color Card, Inc., supra,* 301 F.Supp. 336, 343 (D.C. Ill. 1967).
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> "'* * * Obviousness does not mean that one skilled in the art can perceive the solution after it has been found and pointed out by someone else; the test of obviousness is as of an earlier time, when the search is on. * * *'
>
> "[35 U.S.C. § 103] . . . provides that a patent may not be obtained if, in the light of the prior art, the subject matter as a whole would have been obvious to a person having ordinary skill in the art. The Courts must provide an answer to

> that question, but they should not do so on the basis of subjective speculation as to what, after everything has been disclosed to it, might have seemed obvious to it. . . ." *Honolulu Oil Corporation v. Shelby Poultry Company,* 293 F.2d 127, 131 (4 Cir. 1961); *S. H. Kress & Company v. Aghnides,* 246 F.2d 718, 723 (4 Cir. 1957), cert. den. 355 U.S. 889, 78 S.Ct. 261, 2 L.ed.2d 189.

In appraising obviousness under Section 103, the prior art must be viewed from a point in time just before the invention was perfected. Since many things may seem obvious after they have been made, courts must guard against the use of hindsight. *Merck & Co. v. Chase Chemical Company,* 273 F.Supp. 68, 84 (D.C.N.J. 1967). "Nothing in this world is more obvious than that which is obvious by hindsight *after* the fact of making an invention." *Abington Textile Machinery Works v. Carding Specialists* [*Canada*] *Ltd.,* 249 F.Supp. 823, 834 (D.C.D.C. 1965); *Walt Disney Productions v. Fred A. Niles Com. Ctr., Inc., supra,* 369 F.2d 230, 234 (7 Cir. 1966). ". . . A method of analysis, dissection and reassembly through hindsight always needs close scrutiny. [Citations omitted.]" *Hirs v. DeLaval Turbine, Inc., supra,* 286 F.Supp. 754, 759 (D.C.Fla. 1968). See also, *Application of Warner, supra,* 379 F.2d 1011, 1015 (C.C.P.A. 1967), cert. den. 389 U.S. 1057, 88 S.Ct. 811, 19 L.ed.2d 857, rehearing denied 390 U.S. 1000, 88 S.Ct. 1201, 20 L.ed.2d 101; *Zegers v. Zegers, Inc.,* 365 F.2d 156, 159 (7 Cir. 1966), cert. den. 385 U.S. 948, 87 S.Ct. 320, 17 L.ed.2d 226; *Mott Corporation v. Sunflower Industries, Inc.,* 314 F.2d 872, 879 (10 Cir. 1963); *Duo-Flex Corp. v. Building Service Co.,* 322 F.2d 94 (5 Cir. 1963).

5. The Teachings and/or Application Disclosures of the Patent in Issue Should Not Be Considered in the Course of the Judicial Weighing of Obviousness.

In resolving the obviousness issue herein the District Court gave extensive consideration to the disclosures contained in the application for petitioner's utility patent (310 F.Supp. at 313). This was clearly improper.

> ". . . *The question of obviousness must be weighed without recourse to the disclosure of the applicant's application. In re Sporck,* 301 F.2d 686, 49 CCPA 1039. . . ." [Emphasis added.] *Application of Long, supra,* 347 F.2d 651, 655-656 (C.C.P.A. 1965).

> ". . . In resolving the question of obviousness, *the judicial view must not include the knowledge contributed by the patentee;* the teachings of his patent are irrelevant when determining what 'would have been obvious' to one skilled in the prior art before he created his 'manufacture.' *Application of Aufhauser,* 399 F.2d 275, 277 (C.C. P.A. 1968); *Application of Warner,* 379 F.2d 1011, 1016 (C.C.P.A. 1967)." [Emphasis added.] *Shaw v. E. B. and A. C. Whiting Company,* 417 F.2d 1097, 1105 (2 Cir. 1969).

> ". . . This [the obviousness test of 35 U.S.C. 103] requires us to view the prior art *without reading into that art the teachings of appellant's invention. In re Murray and Peterson,* 268 F.2d 226, 46 CCPA 905." [Emphasis added.] *Application of Sporck, supra,* 301 F.2d 686, 689 (C.C.P.A. 1962).

The federal courts oft-times have been enjoined to ". . . resist the temptation to read into the prior art the teachings of the invention in issue." *Graham v. John Deere Co., supra,* 383 U.S. at 386, 15 L.ed.2d at 566, 86 S.Ct. 684; *Application of Aufhauser, supra,* 399 F.2d 275, 277 (C.C.P.A. 1968).

6. In Applying the Standard of Nonobviousness, the Practical Criteria and Subtests Are Not to Be Judicially Ignored.

The practical difficulties in application of the 35 U.S.C. § 103 nonobviousness test have not gone unnoted:

> "The test laid down is indeed misty enough. It directs us to surmise what was the range of ingenuity of a person 'having ordinary skill' in an 'art' with which we are totally unfamiliar. . . . There are indeed some sign posts: e.g. *how long did the need exist; how many tried to find the way;* how long did the surrounding and accessory arts disclose the means; *how immediately was the invention recognized as an answer by those who used the new variant? . . .*" [Emphasis added.] *Per* L. Hand, *J., Reiner v. I. Leon Co.,* 285 F. 2d 501 (2 Cir. 1960); *Application of Cable, supra,* 347 F.2d 872, 880 (C.C.P.A. 1965).

Additional reference to the economic, motivational and non-technical issues to be interstitially found in the obviousness issue and to be canvassed as a practical aid to the resolution thereof has been made by this Court, *Graham v. John Deere Co.,* 383 U.S. at 36, 15 L.ed.2d at 566, 86 S.Ct. 684, and by the writers, see Note, Subtests of "Nonobviousness": A Nontechnical

Approach to Patent Validity, 112 U.Pa.L.Rev. 1169-1184 (1964).

Particular attention has been given to the appropriateness of determining the questioned patent's commercial success or lack thereof. "Commercial success of the patentee's device, coupled with a showing that the invention filled a long-sought need, is supporting evidence which may be utilized to determine that the invention was not obvious. . . ." *Technicon Instruments Corp. v. Coleman Instruments, Inc., supra,* 255 F.Supp. 630, 640 (D.C. Ill. 1966).

> ". . . the marked commercial success of the invention . . . is entitled to substantial weight in determining whether an improvement amounts to invention. *Goodyear Tire & Rubber Co. v. Ray-O-Vac Co.,* 321 U.S. 275, 64 S.Ct. 593, 88 L.Ed. 721." *Calhoun v. State Chemical Manufacturing Company,* 153 F.Supp. 293, 297 (D.C. Ohio 1957). See also, *American Safety Table v. Schreiber,* 269 F.2d 255, 261 (2 Cir. 1959), cert. den. 361 U.S. 915, 80 S.Ct. 259, 4 L.ed.2d 185.

The District Court herein, however, failed to give any consideration whatever to petitioner's demonstrated commercial success with the patents in issue.

The nature and extent of prior experimentation and the failure of others to devise the structure in question despite repeated attempts is also appropriately to be considered. ". . . One criterion of invention is that others have sought and failed, even where the discovery is simple. . . ." *Tatko Brothers Slate Co. v. Hannon, supra,* 157 F.Supp. 277, 283 (D.C.Vt. 1957), rev'd on other grounds 270 F.2d 571, cert. den. 361 U.S. 915, 80 S.Ct. 260, 4 L.ed.2d 185.

". . . As was said in *Expanded Metal Company v. Bradford,* 214 U.S. 366, on page 381, 29 S.Ct. 652, 656, 53 L.Ed. 1034: 'It may be safely said that if those skilled in the mechanical arts are working in a given field, and have failed, after repeated efforts, to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to a mechanic skilled in the art, and is entitled to protection as an inventor.' " *Pyle Nat. Co. v. Lewin, supra,* 92 F.2d 628, 630 (7 Cir. 1937).

"To say now in retrospect that the patented combination was 'obvious' is totally to ignore the evidence that though the means were well known, *none of the many who worked for years to obtain the result achieved by Schliephacke thought of making this allegedly 'obvious' combination. . . .*" [Emphasis added.] Medina, *J.*, dissenting in *Lorenz v. F. W. Woolworth Co.,* 305 F. 2d 102 (2 Cir. 1962); *Application of Cable, supra,* 347 F.2d 872, 881 (C.C.P.A. 1965). See also *Copeman Laboratories Co. v. General Plastics Corp.,* 149 F.2d 962, 964 (7 Cir. 1945); *Plax Corp. v. Elmer E. Mills Corp.,* 204 F.2d 302, 310 (7 Cir. 1953); *Continental Can Co. v. Anchor Hocking Glass Corp.,* 255 F.Supp. 67, 75 (D.C. Ill. 1965).

But the District Court herein, after comparing and assigning evidentiary weight to the deposition testimony of Victor Paulson and Frederick F. Welsh and the affidavit of Marlin H. Wykoff (310 F.Supp. at 315) [in violation of the doctrine of *Hazeltine Research v. General Electric Co., infra,* 183 F.2d 3, 7 (7 Cir. 1950)],

summarily rejected substantial evidence of the failure of others to perfect a helmet structure similar to petitioner's. All the evidence in the record before the District Court tended to establish the inability of others to devise a satisfactory adapter band and flip-up assembly equivalent to petitioner's.

The District Court declined to give any effect whatever to evidence (deposition of Jack Latta, affidavit of Marlin H. Wykoff) that a substantial market demand pre-existed the development of petitioner's helmet; inappropriately rejected evidence of the use of petitioner's structure by another who had been trying to develop a similar product (*Colgate Palmolive Co. v. Carter Products, Inc.*, 230 F.2d 855 (4 Cir. 1956), cert. den. 352 U.S. 843, 77 S.Ct. 43, 1 L.ed. 2d 59; *Neff Instrument Corporation v. Cohu Electronics, Inc., supra,* 298 F.2d 82, 87 (9 Cir. 1961); and failed to consider at all such criteria as the existence of a felt need for an advancement in the art, the extensiveness of the search for improvements therein, and whether petitioner's device was recognized as valuable in its market.

7. Primary Functionality Does Not Without More Invalidate a Design Patent.

Petitioner does not contend that the District Court erred herein in considering the test as to petitioner's design patent to be essentially one of obviousness, even though its opinion is stated in terms of lack of originality under 35 U.S.C. § 171 (310 F.Supp. at 316); the previously developed standard of invention, now included within the 35 U.S.C. § 103 nonobviousness standard, often has been used synonymously with originality. *Smith v. Whitman Saddle Co.*, 148 U.S. 674, 679, 13 S.Ct. 768, 37 L.ed. 606; *Rains v. Cas-*

cade Industries, Inc., 402 F.2d 241, 245 (3 Cir. 1968).

Petitioner does assert, however, that in the same manner as in connection with the utility patent, the courts below erroneously focused upon the "oldness in the prior art" of *individual* elements of petitioner's design structure, to the exclusion of a proper attention to petitioner's new design as a whole.

> ". . . [S]eparate presence in the prior art of each element of combination will not prevent a finding of invention. . . .
>
> ". . .
>
> 'It is not necessary for a design patent that all the elements of the design be new; it is essential that the elements, whether new or old, be grouped or combined in such a manner as to produce a pleasing appearance, different from what has preceded it. *The fact that the elements of a design patent were old does not establish want of invention in assembling them.* The decisive question is whether or not the design imparts a pleading impression to the eye of ordinary observers.' (Citations omitted.)" [Emphasis added.] *Blumcraft of Pittsburgh v. Citizens & South. Nat. Bank of S.C., supra,* 286 F.Supp. 448, 456 (D.C.S.C. 1968), rev'd on other grounds 407 F.2d 557, cert. den. 395 U.S. 961, 89 S.Ct. 2103, 23 L.ed.2d 747, rehearing denied 396 U.S. 870, 90 S.Ct. 39, 24 L.ed. 2d 125; *Wham-O-Mfg. Co. v. Paradise Mfg. Co.*, 327 F.2d 748 (9 Cir. 1964); *Try-Me Beverage and Compound Co. v. Metropole,* 25 F.2d 138, 139 (D.C.S.C. 1928).

Even more importantly, the courts below (310 F. Supp. at 317; 441 F.2d at 1112) ignored the well established principle that not merely primary, but rather entire utility or functionality, without any non-functional features, is required to invalidate a design patent.

> ". . . the patented feature need not be *primarily* ornamental, as the plaintiff suggests; it suffices that the patented configuration does not involve its utility alone. *Spaulding v. Guardian Light Co.*, 267 F.2d 111 (7th Cir., 1959). . . ." *L. F. Strassheim Co. v. Gold Medal Folding Furniture Co.*, 294 F.Supp. 708, 714 (D.C. Wis. 1968).

8. Patent Litigation Should Not Be Adjudicated Piecemeal by Partial Summary Judgment.

The courts below summarily invalidated Claims 1 and 2 of petitioner's utility patent, but denied summary judgment as to Claim 3 thereof. Sound judicial administration, however, should prompt denial of a motion for summary judgment on certain patent claims when they are intertwined with another claim which is not susceptible of summary adjudication. *Consolidated Packing Machinery Corp. v. General Mills,* 36 F. Supp. 112 (D.C.Del. 1940). ". . . The entire patent controversy between the parties should be settled at one trial. . . ." *Vernay Laboratories, Inc. v. Industrial Electronic Rubber Co.*, 234 F.Supp. 161, 167 (D.C. Ohio 1964). Or as said in *Paul E. Hawkinson Co. v. Dennis,* 166 F.2d 61, 63 (5 Cir. 1948):

> ". . . since this is a patent suit and as such there is a public interest involved, instead of being tried and determined piecemeal, as was attempted here, it ought to be determined as a whole on the

issues of patent validity, infringement and misuse. Tried and determined as a whole, the questions raised upon the issue of plaintiff's unjust and unfair uses and practices in respect of the patent could then be considered in the light of the realities as to whether plaintiff has a patent and whether defendant has infringed it, and not, as was done on this record, by a kind of shadow boxing in vacuo."

"The situation thus seems inappropriate for partial summary judgment. It is like that 'where a portion of an action may be ripe for summary judgment but it is intertwined with another claim(s) that must be tried'. 6 Moore's Federal Practice (2d ed.) 2165. The principle has been found frequently to require denial of motions for summary judgment. . . ."

Kollsman Instrument Corp. v. Astek Instrument Corp., 225 F.Supp. 534, 536 (D.C.N.Y. 1964).

In *E. I. du Pont de Nemours & Company v. Celanese Corporation*, 291 F.Supp. 428, 432 (D.C.N.Y. 1968), the court said: ". . . [S]ince the complaint asserts a single claim for relief and the portions sought to be dismissed may affect the portions which will be tried, partial summary judgment is in any event inappropriate. . . ." See also, *Fraver v. Studebaker Corp.*, 11 F.R.D. 94 (D.C.Pa. 1950); *Burgans v. N.Y. Central R.R. Co.*, 192 F.Supp. 222 (D.C.N.Y. 1961); *Bernardo v. Bethlehem Steel Co.*, 169 F.Supp. 914 (D.C.N.Y. 1959).

9. This Court's Graham and Other Decisions Require the Lower Federal Courts to Exercise Great Caution in Dealing With the Section 103 Obviousness Issue on a Motion for Summary Judgment, Summary Judgment Not Ordinarily Being Appropriate in Patent Cases.

The Rule 56 summary judgment procedure is not ordinarily appropriate for the disposition of a patent case. *Van Brode Milling Co. v. Kravex Manufacturing Corp.*, 21 F.R.D. 246, 249 (D.C.N.Y. 1957). This Court's insistence in *Graham* on an inquiry "beamed with greater intensity on the requirements of §103" (388 U.S. at 19, 15 L.ed.2d at 557, 86 S.Ct. 684) dictates caution as to the issue of obviousness upon a motion for summary judgment. *Intermountain Research & Eng. Co. v. Hercules Incorporated*, 406 F.2d 133, 136 (9 Cir. 1969). In *Poller v. Columbia Broadcasting System, Inc., et al.*, 368 U.S. 464, 467, 82 S.Ct. 486, 488, 7 L.ed.2d 458, this Court said:

> "This rule authorizes summary judgment 'only where the moving party is entitled to judgment as a matter of law, where it is quite clear what the truth is, * * * [and where] no genuine issue remains for trial * * * [for] the purpose of the rule is not to cut litigants off from their right of trial by jury if they really have issues to try.'"

In perhaps the earliest case involving the applicability of Rule 56 in patent infringement actions it was held: "The issues involve the validity and alleged infringement of two unadjudicated patents, and such questions can only be adequately determined after a trial." *Refractolite Corporation v. Prismo Holding Corporation et al.*, 25 F.Supp. 965 (D.C.N.Y. 1938). ". . . [I]n a case where there appears to be an infringement,

the court should not pass on the question of prior art in the validity of the patent, without giving the plaintiff an opportunity to establish his proof at trial. . . ." *Weil v. N. J. Richman Co.,* 34 F.Supp. 401, 402 (D.C.N.Y. 1940). See also, *Van Wormer v. Champion Paper & Fibre Co.,* 28 F.Supp. 813, 815 (D.C. Ohio 1939).

Very numerous later cases have been to like effect. ". . . [I]f summary judgment procedure is to be effectively used by an infringer to permit him to continue to infringe without accountability, the case for summary judgment must be made out clearly and beyond the peradventure of a doubt. . . ." *Paul E. Hawkinson Co. v. Dennis, supra,* 166 F.2d 61, 63 (5 Cir. 1948). ". . . [A] summary judgment on the issue of patent validity should be entered 'only where the matter is free from doubt and where invalidity so clearly appears that no testimony can change its legal aspect.' . . . The complete absence of any genuine issue of fact must be apparent and all doubts thereon must be resolved against the moving party." *Chiplets, Inc. v. June Dairy Products Co.,* 89 F.Supp. 814, 816 (D.C.N.J. 1950). "The public is a silent but an important party in interest in all patent litigation, and we think a patent should neither be invalidated nor sustained except after a trial and upon evidence and a full disclosure of all pertinent facts. . . ." *Long v. Arkansas Foundry Company,* 247 F.2d 366, 369 (8 Cir. 1957). ". . . [T]he presence of a single genuine issue as to a material fact precludes disposition of a case by summary judgment. . . . What the prior art was and what the patentee did to improve upon it are questions of fact. . . ." *Cee-Bee Chemical Co. v. Delco Chemicals,* 263 F.2d 150, 153 (9 Cir. 1958).

Or in the language of two very noted federal judges, Chase and Learned Hand of the Second Circuit:

> ". . . if liability is dependent upon any disputed questions of fact, the party opposing the motion has the right to have those questions determined upon a trial. . . .
>
> ". . .
>
> "Were we skilled in the art it might be simple to determine whether there was any 'genuine issue' as to any material fact with respect to the anticipation of the second Rotheim patent, but we lack that special knowledge which would permit us to read the patents so understandingly. . . ." *Bridgeport Brass Co. v. Bostwick Laboratories,* 181 F. 2d 315, 316, 319 (2 Cir. 1950).
>
> ". . . In determining whether summary judgment should be granted judges may not leap beyond the boundaries marked by experts and declare as laymen in the art that a new article or design is either obvious or non-obvious. As L. Hand, J., remarked: 'Courts, made up of laymen as they must be, are likely either to underrate, or to overrate the difficulties in making new and profitable discoveries in fields with which they cannot be familiar * * *.'" *Rains v. Cascade Industries, Inc., supra,* 402 F.2d 241, 247 (3 Cir. 1968); *Safety Car Heating & Lighting Co., Inc. v. General Electric Co.,* 155 F.2d 937, 939 (2 Cir. 1946).

Although it is well established that on motion for summary judgment the court's function is not to decide issues of fact but merely to determine whether there are such issues to be tried, *Hazeltine Research v. General Electric Co., supra,* 183 F.2d 3, 7 (7 Cir. 1950), the

opinion of the District Court herein clearly indicates that Court did decide factual issues by comparing statements of the various deponents and assigning evidentiary weight to each. This error was not cured by the lower courts having physically viewed and examined (441 F.2d at 1111) the two helmet structures involved. *Reiser v. McKee Glass Co.*, 1 F.R.D. 170 (D.C.Pa. 1940).

See also, denying summary judgment as to patent validity, *Electronized Chemicals Corp. v. Rad-Mat, Incorporated*, 228 F. Supp. 781, 785 (D.C. Md. 1968); *Kierulff Associates v. Luria Brothers & Company*, 272 F.Supp. 537, 540 (D.C.N.Y. 1967); *Sealectro Corporation v. L. V. C. Industries, Inc.*, 271 F. Supp. 835, 842 (D.C.N.Y. 1967); *Devex Corporation v. Houdaille Industries, Inc.*, 382 F.2d 17, 21 (7 Cir. 1967); *Ortman v. Stanray Corporation*, 371 F.2d 154, 156 (7 Cir. 1967); *Technograph Printed Circuits v. Methode Elect., Inc.*, 356 F.2d 442, 447, 449 (7 Cir. 1966), cert. den. sub nom. *Croname, Inc. v. Technograph Printed Circuits, Ltd.*, 384 U.S. 950, 86 S.Ct. 1570, 16 L.ed.2d 547; *Warner v. Swasey Company v. Held*, 256 F.Supp. 303, 308 (D.C.Wis. 1966); *Kollsman Instrument Corp. v. Astek Instrument Corp., supra*, 225 F.Supp. 534, 536 (D.C.N.Y. 1964); *Keuffel & Esser Company v. Charles Bruning Co.*, 219 F.Supp. 195, 198-200 (D.C.N.J. 1963); *National Screen Service Corp. v. Poster Exchange, Inc.*, 305 F. 2d 647, 651 (5 Cir. 1962); *Hughes Blades, Inc. v. Diamond Tool Associates*, 300 F.2d 853, 854 (9 Cir. 1962); *Servaas & Company v. Dritz*, 185 F.Supp. 61, 63 (D.C.N.Y. 1960); *Boyajian v. Old Colony Envelope Company*, 279 F.2d 572, 575 (1 Cir. 1960); *Neff Instrument Corporation v. Cohu Electronics, Inc., supra*, 269 F.2d 668, 669 (9 Cir. 1959);

American Securit Company v. Hamilton Glass Company, 254 F.2d 889, 892 (7 Cir. 1958); *Adams v. Columbus Manufacturing Company,* 169 F.Supp. 346, 348 (D.C. Ga. 1958); *Reynolds Pen Co. v. W. A. Sheaffer Pen Co.,* 22 F.R.D. 502, 504 (D.C.N.Y. 1958); *Vermont Structural Slate Co. v. Tatko Bros. Slate Co.,* 134 F.Supp. 4, 5 (D.C.N.Y. 1955), aff'd. 233 F.2d 9, cert. den. 353 U. S. 917, 77 S.Ct. 216, 1 L.ed.2d 123; *Chenault v. Nebraska Farm Products,* 107 F.Supp. 635, 638 (D.C. Neb. 1952); *Traylor v. Black, Sivalls & Bryson, Inc.,* 189 F.2d 213, 216 (8 Cir. 1951); *Van Dette v. Aluminum Air Seal Mfg. Co.,* 11 F.R.D. 558, 559 (D.C. Ohio 1951); *Bucky v. Sebo,* 97 F.Supp. 277, 279 (D.C.N.Y. 1951); *Bede v. Beck,* 11 F.R.D. 293, 294 (D.C. Ohio 1951); *Gray Tool Co. v. Humble Oil & Refining Co.,* 186 F.2d 365, 366, 370 (5 Cir. 1951), cert. den. 341 U.S. 934, 71 S.Ct. 854, 95 L.ed. 1363; *Fluid Systems v. Great Lakes Equipment Co.,* 98 F.Supp. 220, 221 (D.C. Ohio 1951); *Staffin Lewis Corporation v. Rose Derry Co.,* 9 F.R.D. 704, 705-706 (D.C. Mass. 1950); *Burt v. Bilofsky,* 9 F.R.D. 299, 300 (D.C.N.J. 1949); *Union Nat. Bank of Youngstown v. Superior Steel Corp.,* 9 F.R.D. 123, 124 (D.C. Pa. 1949); *Engineering Develop. Lab. v. Radio Corp. of America,* 153 F.2d 523, 525 (2 Cir. 1946); *E. W. Bliss Co. v. Cold Metal Process Co.,* 47 F.Supp. 897, 899 (D.C. Ohio 1942); *Dairy Engineering Corporation v. De-Raef Corp.,* 1 F.R.D. 679 (D.C. Mo. 1941); *Charles Blum Advertising Corporation v. L. & C. Mayers Co.,* 25 F.Supp. 934, 935 (D.C.Pa. 1938).

Conclusion.

For the foregoing reasons a writ of certiorari should issue to review the judgment and opinion of the Ninth Circuit.

Respectfully submitted,

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Attorney for Petitioner.

APPENDIX A.

Opinion of the Court of Appeals for the Ninth Circuit.

United States Court of Appeals for the Ninth Circuit.

Bates Industries, Inc., Appellant, v. Daytona Sports Co. and Daytona Products, Inc., and Paulson Manufacturing Corporation, Appellees. NO. 25096-97.

Appeal from the United States District Court for the Central District of California.

Before: MERRILL, ELY and TRASK, Circuit Judges.

PER CURIAM:

This is an appeal from the granting of a summary judgment in a patent infringement action which held invalid a utility patent and a related design patent, both of which covered a motorcycle-type protective helmet with a pivotally attached flip-up face shield. The district court found that the patented invention was not really inventive over the prior art, but merely a combination of old elements which did not accomplish a new result. According to both parties herein, the district court found, in effect, that the helmet in question was "obvious" in light of the prior art (35 U.S.C. § 103).[1] The action arises out of the patent laws of the United States. Jurisdiction is based upon 28 U.S.C. § 1338(a).

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[1]35 U.S.C. § 103 provides, in part:

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains . . ."

Daytona Sports Co. and Daytona Products, Inc. (Daytona) contend the appellant's utility patent and design patent are invalid. Daytona asserts that the utility patent was obvious from an unpatented visor assembly commonly known and sold publicly more than a year prior to the date of plaintiff's application. It was produced and sold by McHal Enterprises. Daytona contends that the design patent is invalid because the distinctive features relied upon by the plaintiff are essentially functional in nature and not new and original.

The district court carefully examined the claims of the plaintiff for its product and compared them with the McHal visor, and viewed the two products.[2] This court did likewise. The district court held that the utility patent claimed by the plaintiff was invalid because it was not inventive over the prior art. It held that the design patent was invalid because it was not new and original and also because its claimed distinctive features are primarily functional. We agree as to both patents.

The patented invention of the plaintiff consists of a transparent plastic shield made to curve around the face and attach at the top to a crash helmet. It is constructed so that it may be flipped up over the helmet and away from the face if desired. The prior art consisting of the McHal product has a similar face shield which also flips up but it also has a narrow visor or brim. Both products were displayed in court, demonstrated at length and explained in detail. A photograph of a similar helmet and visor from a

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[2]The district court's opinion may be found in 310 F.Supp. 311 (C.D. Cal. 1969).

British cycle magazine was also pointed to as a part of the prior art.

The scope of the court's factual inquiries has been well defined under 28 U.S.C. § 103, *supra:*

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained, and the level of ordinary skill in the pertinent art resolved." *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966).

Appellant contends that the evidence demonstrates that there is an issue of material fact as to the level of ordinary skill in the pertinent art which could not be resolved on a motion for summary judgment. *Intermountain Research & Engineering Co., Inc. v. Hercules, Inc.*, 406 F.2d 133 (9th Cir. 1969). That is, there exists an issue respecting the capacity of one with ordinary skill in the art to alter, modify or combine the prior art to duplicate the patented device.

Appellees contend that where the subject matter and the differences between the alleged invention and the prior art are so simple and requiring of no explanation that the claimed invention would have suggested itself to those with ordinary skill in the art, even if that skill is postulated at the minimum conceivable level, there can be no genuine issue of fact and summary judgment is proper. *Walker v. General Motors Corp.*, 362 F.2d 56, 59 (9th Cir. 1966). In other words, appellees argue that there can be no genuine issue of fact as to the level of skill in the art because the claimed invention herein would be obvious even if the ordinary skill was at a very primitive level. The fact that others failed in attempts to devise a similar

structure is immaterial if the claimed patent is obvious. *Jeddeloh Brothers Sweed Mills, Inc. v. Coe Manufacturing Co.*, 375 F.2d 85 (9th Cir.), *cert. denied*, 389 U.S. 823 (1967); *Alladin Plastics, Inc. v. Jerrold Stephan Co.*, 362 F.2d 532 (9th Cir. 1966).

With respect to the claimed design patent this court has stated:

> "In order for a design patent to be valid, it must be: (1) new, (2) original, (3) ornamental, (4) non-obvious to a person of ordinary skill in the art, and (5) not primarily for the purpose of serving a functional or utilitarian purpose." *Barofsky v. General Electric Corp.*, 396 F.2d 340, 342 (9th Cir. 1968), *cert. denied*, 393 U.S. 1031 (1969).

The same considerations which compel a conclusion against appellant with respect to the utility patent prevail as to the design patent. The differences relied upon are not non-obvious and also, as to design, are primarily in the functional field.

The only remaining issue is the trial court's refusal to award attorney fees to Paulson on its cross appeal. Patent law provides that only in "exceptional cases" may a court award reasonable attorney fees to the prevailing party. 35 U.S.C. § 285. That determination is primarily a matter for the exercise of district court discretion. *Ashcroft v. Papermate Mfg. Co.*, 434 F.2d 910, 915 (9th Cir. 1970). The district court here declined on the evidence to award attorney fees. We do not disturb that action.

Judgment affirmed.